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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,655	11/12/1999	BRIAN D. MORRISON	1843	1910

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ELLEN T DEC GENERAL COUNSEL  
NATIONAL STARCH AND CHEMICAL COMPANY  
BOX 6500  
BRIDGEWATER, NJ 088070500

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 02/12/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/439,655

Applicant(s)

MORRISON ET AL. 

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02/28/02;07/22/02;11/19/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 1,6 and 8 is/are objected to.
- 8) ☒ Claim(s) 12 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

**Election/Restrictions**

1. **Newly submitted claim 12 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The originally presented invention(claims 1-9 and now 1-11) is drawn to a hot melt adhesive composition and an article such as a carton, tray or case derived therefrom VS the newly presented invention(claim 12) drawn to a method of bonding substrates. The inventions are separate and distinct, each from the other as per having been related as product and process of using. In this case, the hot melt adhesive can be used in a paper coating process which involves the use of a single substrate and applied at different temperatures.**

**Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 12 has been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.**

**Information Disclosure Statement**

2. **The information disclosure statement filed on 02/28/02 has been acknowledged and placed in the application file. The prior art cited is noted with interest and considered merely cumulative to the prior art infra.**

**Terminal Disclaimer**

3. **The terminal disclaimer filed on 03/04/02 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. patent 6,117,945 has been reviewed and is accepted. The terminal disclaimer has been recorded. Therefore, the rejection of the instantly claimed invention(claims 1-11) over the claims(1-24) of U.S. Patent 6,117,945 has been removed.**

**Claim Objections**

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4. **Claims 1, 6 and 8 are objected to because of the following informalities: It is suggested that applicants insert a hyphen(-) between "ethylene" and "vinyl acetate", consistent with art accepted terminology. Appropriate correction is required.**

**Claim Rejections - 35 USC § 102**

5. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

**A person shall be entitled to a patent unless –**

**(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.**

6. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.**

7. **Claims 1-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mehaffy et al as per reasons clearly stated in the Grounds of Rejection of record per paper no. 3, 08/20/01, paragraph no. 9. Further, Mehaffy et al teach that the hot melt adhesives can be applied at temperatures of 200 to 300 degrees F, compatible adhesive promoting tackifiers include a terpene phenolic resin(col. 1, lines 59-60 and col. 2, lines 41-50, respectively).**

**Claim Rejections - 35 USC § 102**

8. **Claims 1-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kosaka et al, Bodouoglou or Liedermoo et al as per reasons clearly stated in a previous Office Action per paper no. 3, 08/20/01, paragraph no. 10. Further, Kosaka et al teach that the composition can be used at temperatures of 90 to 230 degrees C(194-446 degrees F) and operable tackifying resins include terpene/phenolic resins(col. 1, lines**

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*34-53, col. 2, lines 43-49 and Run 1, which uses a temperature of 150 degrees C = 302 degrees F). Bodouoglou teach that the primer adhesive composition can be preferably applied at temperatures of about 310 degrees C and the cover glue layer can be preferably applied at temperatures of about 335 degrees C and that suitable tackifying resins for both the primer adhesive layer and the cover glue layer include phenolic modified terpene resins(col. 4, lines 3-46 and col. 6, lines 28-50, respectively). Liedermooy et al teach that the adhesives can be applied at temperatures of 107 to 135 degrees C which translates to 224 to 275 degrees F and that operable tackifying resins include terpene phenolic resins(see the Abstract and col. 3, lines 1-3, respectively).*

#### **Response to Arguments**

9. ***Applicant's arguments filed 07/22/02 & 07/22/02 have been fully considered but they are not persuasive.***

***Relative to Mehaffy et al— With all due respect to Counsel's opinion, the rejection of the claimed invention over Mehaffy et al is proper. Mehaffy et al has a common inventor/assignee with the instant application and based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). Only for applications filed on or after November 29, 1999, might this rejection be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2). The instant application was filed on November 12, 1999.***

***Relative to Kosaka et al—The claims, in their present form, simply do not preclude the "filler" and "pigment" components of Kosaka et al. Counsel is reminded that "comprising" leaves the claim open for the inclusion of unspecified ingredients even in major amounts(Ex parte Davis et al, 80 USPQ 448). As to the melt index of the vinyl acetate copolymer taught via the disclosure of Kosaka et al(4 to 1000 g/10 min), such encompasses the claimed melt index. Counsel is***

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*reminded that a reference is evaluated, as a whole for what it fairly teaches and is in noway limited to the working Runs.*

***Relative to Bodouroglou—It is urged that the application temperatures of between about 310 and about 360 degrees F of the primer and between about 335 and about 365 degrees F of the cover adhesive, given its broadest reasonable interpretation, meets the claimed application temperature of 300 degrees F since "about" is relative and not absolute. More specifically, these application temperatures are "preferable" temperatures which necessarily implies that temperatures slightly lower would be operable within the scope of patentees invention. There is absolutely nothing viable on this record diffusing this issue.***

***Relative to Liedermooy et al—Firstly, the application temperatures of the adhesives of Liedermooy et al include temperatures of 224 to 275 degrees F and clearly overlap in scope with the claimed application temperatures. Secondly, the ethylene-vinyl acetate copolymer of Liedermooy et al clearly overlaps in scope with the claimed ethylene-vinyl acetate copolymers.***

#### **Conclusion**

**10. The additional prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is cited as of interest in teaching hot melt adhesives containing at least an ethylene-vinyl acetate copolymer, a wax component and a tackifying resin and considerably merely cumulative to the prior art supra.**

**11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).**

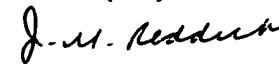
**A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.**


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***Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..***

***If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.***

***Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.***

  
**Judy M. Reddick  
Primary Examiner  
Art Unit 1713**

**JMR   
February 8, 2003**

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